

REMARKS

Claims 1-9, 11-13, and 16-23 are pending.

Rejections under 35 U.S.C. §102(b)

Claims 1, 5, 7, 8, 11, and 16-20 stand rejected as being anticipated by U.S. Patent No. 5,523,794 by Mankovitz et al. (hereinafter “Mankovitz”). The Applicant respectfully submits that claim 1 defines at least the following advantageous distinctive features that distinguish over and avoid Mankovitz:

“a receiver configured to receive an electronic wireless transmission containing coupon information,”

“a configurable portable electronic communication device,” and

“means for improving the first scan rate of the scannable coupon from the electronic display of the configurable portable electronic communication device.”

All words in a claim must be considered in judging the patentability of that claim against the prior art when determining patentability. The electronic coupon of Mankovitz does not disclose or suggest a receiver configured to receive an electronic wireless transmission containing coupon information. Mankovitz discloses a portable coupon device having an infrared (*i.e.* optical) receiver **16** and a serial port connector **20** for a cable for transferring information to and from the controller **12**. Neither an optical receiver nor a serial cable is a receiver configured to receive an electronic wireless transmission. Thus, Mankovitz does not disclose the recited receiver and cannot anticipate claim 1. The Applicant further urges that claim 8 is patentable for at least similar reasons, and that method claim 16 is patentable because the step of receiving encrypted coupon information over a wireless electronic link is not disclosed in Mankovitz.

Claim 1 also recites a configurable portable electronic communication device in the body, as well as in the preamble, of claim 1, and therefore this limitation must be considered. The electronic coupon disclosed in Mankovitz is a specialized article, namely a portable data coupon,

and is not a configurable portable electronic communication device. The Applicant provides examples of portable electronic devices on page 4, lines 14-23 of the *Written Description*. In light of the language of claim 1 and the definition provided in the *Written Description*, Mankovitz does not disclose the recited configurable portable electronic communication device and therefore cannot anticipate claim 1. Claim 16 is also patentable for similar reasons.

Claim 1 also recites means for improving the first scan rate of the scannable coupon from the electronic display of the configurable portable electronic communication device. The Examiner states that Mankovitz discloses a strobe rate and persistence level inherently of sufficient magnitudes to make the portable coupon device work, and that the performance of the portable coupon device of Mankovitz is taken to be an *improved* performance of an LCD having lower strobe rates and/or persistence levels (emphasis in original). Following this line of reasoning, any operative device could be considered to have improved performance, and no changes to operative devices that improved their performance would ever be patentable. However, this position is inconsistent with long-standing law and practice (see, e.g. 37 C.F.R. §1.71(b).)

Furthermore, the Applicant teaches the particular desirability of the combination of the recited means for improving the first scan rate of a scannable coupon from an electronic display of a configurable portable electronic communication device. The Examiner takes Official Notice that it is well known that the quality of a barcode output is related to the success in registering an error-free scan, and that it would be obvious to one of ordinary skill to have provided a high quality barcode display so as to avoid errors. However, whether it would have been obvious to one of ordinary skill to have provided a high quality barcode display is not relevant to a rejection of a claim under 35 U.S.C. §102(b). This recited element of claim 1 is not found in Mankovitz, and hence claim 1 cannot be anticipated by Mankovitz. Therefore, for at least the reasons given above, the Applicant believes claim 1 and all claims that depend from claim 1 are allowable.

Even if a similar rejection of claim 1 were based on 35 U.S.C. §103, no teaching or suggestion is provided in the cited art as to how to improve the first scan rate of a barcode displayed on an electronic display of a configurable portable electronic communication device. While it may have been generally known to “to have provided a high quality barcode display so as to avoid errors,” this does not correctly represent the level of knowledge and skill required to achieve the invention of claim 1. It is the Applicant who recognized the problems arising from scanning barcodes from electronic displays and who teaches specific solutions for improving the

first scan rate of barcodes on an electronic display.

The Applicant respectfully traverses and objects to the Examiner's Notice in support of the rejection of claim 1, and urges, in light of the specialized and relatively esoteric technology involved with scanning barcodes from electronic displays, as compared to scanning barcodes printed on a paper coupon, for example, that such Notice be supported by citation to reference work recognized in the pertinent art so that the Applicant is given the opportunity, in the Patent Office, to challenge the correctness of the assertion or the notoriety or repute of the cited reference (see, *In re Pardo*, 684 F.2d, 912, 214 USPQ 673, 677 (CCPA 1982); see also, *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1553, 220 USPQ 303, 312-13 (Fed Cir. 1985)). Accordingly, the Applicant respectfully requests additional proof from the Examiner or an affidavit under 37 C.F.R. §1.104(d)(2).

Regarding claims 7 and 16, the Examiner states that Mankovitz teaches that the source coupon date is encrypted and that the portable coupon devices are taken to inherently provide decryption. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. Decryption may occur in the controller 12 of Mankovitz, rather than the portable coupon device, thus the missing descriptive matter is not necessarily present in the prior art and no *prima facie* case of inherency has been made. Therefore, claims 7 and 16 are further patentable.

Regarding claim 8, the Examiner states that Mankovitz teaches that different coupon formats can be displayed, and that the alphanumeric representation of the coupon can be taken to be a second barcode format. The Applicant respectfully traverses. First, this position appears to be inconsistent with the position taken by the Examiner in the final Office action mailed 08/25/2003 and on page 6 of the instant Office action, in which the Examiner stated that Mankovitz teaches that a single coupon's data can be represented in alphanumeric, which is easily understandable by humans, and barcode- easily understandable by machines. The position taken by the Examiner in the final Office action and on page 6 of this Office action suggests that coupon data in an alphanumeric format was not considered to be a barcode format. Second, *Getting Started with Bar Codes: a Systematic Guide*, which is listed in the Notice of References Cited provided with the instant Office action, explains that a "symbology standard" of a bar code relates to how numbers and letters are represented in an array of bars and spaces (see page 30; see also, Office action, page 6, line 17). Thus, this reference distinguishes between barcode formats, namely an array of bars and spaces, and letters and numbers, *i.e.* alphanumeric

characters. Finally, the Applicant provides several examples of barcode formats on page 5, line 11, and believes that one of ordinary skill in the art would not consider alphanumeric data to be a scannable barcode format.

The Examiner now urges that alphanumeric representation of the coupon can be taken to be a second barcode format because alphanumeric data can be scanned by an imaging scanner or OCR device. However, merely scanning alphanumeric characters does not transmogrify them into a barcode. In order to anticipate claim 8, Mankovitz must disclose a memory containing a computer-readable program for generating a scannable coupon on an electronic display of a configurable portable electronic communication device from coupon information and including instructions for converting the scannable coupon from a first scannable barcode format to a second scannable barcode format. Mankovitz does not disclose this recited element of claim 8; therefore, claim 8 is patentable.

Claim 22 stands rejected under 35 U.S.C. § 102(b) as being anticipated by PCT International Patent Publication No. WO 00/39657 by Greenberg et al. (hereinafter “Greenberg”). 35 U.S.C. § 102(b) states that a person *shall be entitled* to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States (emphasis added). The instant application was filed with the U.S. Patent and Trademark Office on July 26, 2000. Greenberg has an International Publication Date of July 6, 2000, which is not more than one year prior to the date of application for patent in the United States. The Examiner has not provided evidence of earlier publication, earlier patent or public use or sale in this country more than one year prior to the date of application for patent in the United States. Therefore, the Applicant respectfully requests the removal of this reference and the allowance of claim 22.

Rejections under 35 U.S.C. §103

Claims 2-4, 6, 9, 12, 13 and alternatively claims 7, 8, 16-20 are rejected as being unpatentable over Mankovitz. The Examiner takes Official Notice that it is well known to provide displays with various levels of visual clarity by manipulating pixel resolution and sizing as well as antireflective contrast coatings. The Applicant objects to this Official Notice because it does not represent the level of ordinary skill necessary to support these rejections. It is unreasonable for the Examiner to assert that one knowing how to improve visual clarity would

know how to improve the first scan rate of a scannable coupon from an electronic device. If nothing else, the problem must be identified before one would be led to manipulate pixel resolution, sizing, or contrast. The only identification of problem of first scan errors from electronic displays and teachings of how to reduce first scan errors is found in the teaching of the Applicant. Accordingly, the Applicant respectfully requests additional proof from the Examiner or an affidavit under 37 C.F.R. §1.104(d)(2).

The Examiner asserts that the plurality of values for each of the various display characteristics disclosed as various operative examples suggests a lack of criticality regarding those characteristic values, and that one of ordinary skill would have been clearly motivated to routinely experiments with display characteristics so that barcodes were displayed with sufficient clarity so that they can be successfully scanned. The Applicant respectfully traverses, and urges that the plurality of values for various display characteristics evidences the diligence of the Applicant in providing solutions to the problem he identified, namely first scan rate errors from electronic displays.

Furthermore, merely experimenting with display characteristics to obtain an electronic display that could be scanned adds nothing more than is disclosed in Mankovitz, which is addressed above in support of claim 1. In particular, there is no convincing line of reasoning as to why routine experimentation as urged by the examiner would result in the specific elements of the rejected claims, particularly since the problem of first scan errors is recognized only by the Applicant. One of ordinary skill would not have been motivated to optimize a parameter to solve the problem of first scan errors if he did not recognize the parameter as an operative variable affecting first scan error rate.

Regarding claim 8, the Examiner takes Official Notice that it is well known to provide computer devices with ability to convert data into different formats, such as different languages, and asserts that it would have been obvious to one of ordinary skill to have provided the ability for the device of Mankovitz to convert the coupon data into several machine-readable barcode symbologies (formats) so that different POS operators and different POS scanners requiring various barcode formats can process the coupons. The Applicant respectfully traverses. The Notice that computer devices convert data into different languages is not relevant to claim 8 because it does relate to converting a scannable coupon from a first scannable barcode format to a second scannable barcode format in a configurable portable electronic communication device. The Examiner's assertions beyond the Notice are without support or citation to reference, and appear to use the Applicant's teachings not only as a template to construct this

rejection, but also for disclosure of the recited elements, which are not found in the prior art references. Accordingly, the Applicant respectfully requests additional proof from the Examiner or an affidavit under 37 C.F.R. §1.104(d)(2).

The motivation asserted by the Examiner mirrors the Applicant's own teachings (see the *Written Description*, page 5, lines 14-18, for example). The desirability to do what the Applicant has done is not recognized or suggested by the prior art. The Applicant's teachings cannot be used against him in a rejection. Therefore, the Applicant believes claim 8 is allowable and respectfully requests reconsideration of claim 8 and removal of this rejection.

Claim 22 stands rejected as being unpatentable over U.S. Patent No. 5,870,030 by Deluca et al. (hereinafter "Deluca") in view of U.S. Patent No. 6,532,375 by Cathey et al. (hereinafter "Cathey"). The Examiner cites Deluca for teaching electronic coupons sent wirelessly to a pager having a processor, memory and programming to display a bar-coded version of the coupon data on the screen so that it can be operatively scanned by a POS scanner, and cites Cathey for disclosing the idea of a combined pager and cell phone. The Examiner asserts that it would have been obvious to one of ordinary skill to have included cell phone circuitry in the communication device of Deluca so that communications can be sent to telephones as well as paging systems. The Applicant respectfully traverses.

No suggestion to modify the pager of Deluca according to the disclosure of Cathey arises because including cell phone circuitry in the pager of Deluca would require substantial reconstruction and/or redesign of the pager of Deluca. In this case, the Examiner urges adding the substantial complexity of a cell phone to the relatively simple pager of Deluca. The Applicant respectfully asserts that a *prima facie* case of obviousness has not been established and that claim 22 is patentable.

Claim 23 stands rejected as being unpatentable over Deluca in view of U.S. Patent No. 5,285,496 by Frank et al. (hereinafter "Frank"). The Examiner urges that the pager of Deluca alone could be taken to be a "personal digital assistant;" however, the Examiner cites Frank for disclosing the idea of providing calendaring and appointment functionality with pagers. The Applicant distinguishes between a pager and a PDA on page 4, line 14 of the *Written Description*, and traverses the Examiner's position that a pager could be taken to be a PDA.

No suggestion to modify the pager of Deluca according to the disclosure of Frank arises because including calendaring and appointment functionality in the pager of Deluca would require substantial reconstruction and/or redesign of the pager of Deluca. Furthermore, the Examiner's assertion that the proposed combination is taken to provide a "personal digital assistant" is presented without extrinsic

support. Accordingly, the Applicant respectfully requests additional proof from the Examiner or an affidavit under 37 C.F.R. §1.104(d)(2). The Applicant respectfully asserts that a prima facie case of obviousness has not been established and that claim 23 is patentable.

Claim 23 stands rejected as being unpatentable over Greenberg. As discussed above in support of claim 22 being anticipated by Greenberg, it is not clear that Greenberg qualifies as prior art under 35 U.S.C. §102(b), or any other section. The Applicant respectfully requests removal of this reference and allowance of claim 23.

CONCLUSION

In view of the foregoing, the Applicant believes all claims pending in this Application are in condition for allowance, and that the Applicant is entitled to the claims in accordance with Title 35 of the United States Code, and Art.1, §8, cl.8 of the Constitution of the United States. The Applicant respectfully requests reconsideration of all pending claims, the withdrawal of all rejections, and the issuance of a formal Notice of Allowance at an early date.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner believes this amendment does not put all pending claims in condition for allowance, the undersigned invites the Examiner to telephone the undersigned at (707) 591-0789.

Respectfully Submitted



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